

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as First Class Mail, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

Dated: August 4, 2008

Signature: _____

(William A. Di Bianca)

Docket No.: SPINE 3.0-437 CIPCIPCIPCIPCIPCON VI
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Errico et al.

Application No.: 10/784,597

Confirmation No.: 8309

Filed: October 12, 2004

Art Unit: 3738

For ARTIFICIAL INTERVERTEBRAL DISC
: TRIALS HAVING A CYLINDRICAL
ENGAGEMENT SURFACE

Examiner: B. E.
Pellegrino

RESPONSE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants' following remarks are in response to the 37 CFR 1.105 Requirement for Information due on June 2, 2008. Applicants submit a two month extension of the term up to and including August 4, 2008 herewith.

37 CFR 1.105 states in part that in the course of examining a matter the Examiner may require the submission of such information that "may be reasonably necessary to properly examine or treat the matter." There is no requirement on the Applicants to self-examine the matter. Determining what might be subject to double patenting is part of the examination process and not the responsibility of the Applicants.

While the Applicants disagree with the requirement imposed on them, in the spirit of expediting the prosecution of the present application, Applicants have submitted terminal disclaimers herewith, not to be taken as an admission that there are in fact double patenting issues.

In the Requirement for Information, the Examiner asserted that there are numerous other co-pending applications and issued patents, which disclose and claim very similar and/or identical subject matter. Specifically, the Examiner asserted claims 1, 10-12 and 14 of the current application are similar in scope to claims 1-6 and 12 of pending Application No. 10/663,488 ("the '488 application"), since they only vary in functional language and the '488 application claims a combination with a tool. Applicants respectfully submit that all of the inventors of the present application are common with those of the '488 application. Regardless of whether Applicants agree or disagree with the Examiner's characterization of claims 1, 10-12 and 14 of the current application in view of claims 1-6 and 12 of the '488 application, Applicants have submitted herewith a terminal disclaimer with respect to the '488 application to overcome any non-statutory double patenting rejection.

Further, the Examiner asserted, without rejection, that claims 1, 10-12, 14 and 18-20 of the current application differ from claims 1, 10-19 of U.S. Patent No. 7,223,291 ("the '291 patent") in "only the obvious variation of an articulatable coupling vs. an immovable trunk or post." No analysis was provided to support this conclusion, and therefore a *prima facie* case of obviousness has not been established. While the Applicants believe the currently pending claims of the present application are patentably distinct from those recited in the '291 patent, Applicants have filed a terminal disclaimer with respect to the '291 patent herewith.

At this time, Applicants request that the Examiner examine the pending claims on their merits. If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he telephone Applicants' attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

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If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: August 4, 2008

Respectfully submitted,

By 

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